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Docket No.: 205057US0SRD

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/813,990
Applicants: Minako HIJIKATA, et al.
Filing Date: March 22, 2001
For: GENETIC POLYMORPHISM OF MXA PROTEIN AND USE THEREOF
Group Art Unit: 1634
Examiner: Arun K. Chakrabarti

SIR:

Attached hereto for filing are the following papers:

Response to Restriction Requirement

Our check in the amount of **$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO.: 205057US0SRD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: : GROUP ART UNIT: 1634

Minako HIJIKATA, et al.

SERIAL NO.: 09/813,990 : EXAMINER: Arun K. CHAKRABARTI

FILED: March 22, 2001

FOR: GENETIC POLYMORPHISM OF MXA PROTEIN AND USE THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON D.C. 20231

SIR:

Responsive to the Official Action dated February 25, 2003, Applicants elect, with traverse, Group I, Claims 18-24, and 46, drawn to polynucleotide having SEQ ID NO: 1, for further prosecution.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 18-24, and 46, drawn to polynucleotide having SEQ ID NO: 1;

Group II: Claims 25-31, drawn to polynucleotide having SEQ ID NO: 2;

Group III: Claims 32-38, and 48 drawn to polynucleotide having SEQ ID NO: 3; and

Group IV. Claims 39-45, and 49 drawn to polynucleotide having SEQ ID NO: 4.

Applicants elect, with traverse, Group I, Claims 18-24, and 46, drawn to polynucleotide having SEQ ID NO: 1, for further prosecution.

The Office has characterized the inventions of Groups I and II-IV as related as combination and subcombination. Citing MPEP §806.05(c) the Office suggests that the "the invention of Group I has separate utility such as production of RNA and proteins which are obviously different from Groups I-IV because the nucleotide sequences of SEQ ID NO: 1 of Group I is different from SEQ ID Nos: 2-4 of Groups II-IV". However, the Office has not provided sufficient reasons and/or examples to support this assertion. Further, the Office has not shown how this "separate utility" is "materially different" than that of Groups II-IV. The Office has merely stated a conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups II and III-IV as related as combination and subcombination. Citing MPEP §806.05(c) the Office suggests that the "the invention of Group II has separate utility such as production of RNA and proteins which are obviously different from Groups III-IV because the nucleotide sequences of SEQ ID NO: 2 of Group II is different from SEQ ID Nos: 3-4 of Groups III-IV". However, the Office has not provided sufficient reasons and/or examples to support this assertion. Further, the Office has not shown how this "separate utility" is "materially different" than that of Groups III-IV. The Office has merely stated a conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups III and IV as related as combination and subcombination. Citing MPEP §806.05(c) the Office suggests that the "the

invention of Group III has separate utility such as production of RNA and proteins which are obviously different from Groups IV because the nucleotide sequences of SEQ ID NO: 3 of Group III is different from SEQ ID NO: 4 of Group IV". However, the Office has not provided sufficient reasons and/or examples to support this assertion. Further, the Office has not shown how this "separate utility" is "materially different" than that of Groups IV. The Office has merely stated a conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

Applicants further traverse the Restriction Requirement on the additional ground that a search of all the claims would not impose a serious burden on the Office. The MPEP in §803 states as follows:

> "If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

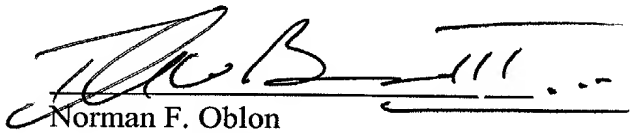
Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. Applicants respectfully point out that thousands of U.S. patents have issued in which many more subclasses are searched, and the Office cannot reasonably assert that a burden exists in searching these subclasses.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants further submit that this application is in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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